UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/576,754	05/23/2000	Douglas R. Adler	99,993	4219

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ART UNIT	PAPER NUMBER
2179	

DATE MAILED: 07/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *04 May 2004*.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-29* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-29* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some *   c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to communications: Amendment filed 5/4/2004.

2.   Claims 1-20 and 22-29 are pending in this case. Claims 1, 8, 15, 22, and 28 are independent claims. Claim 21 has been cancelled.

3.   The rejection of claims 8-9, 13, 15-18, 20-23, and 25-27 under 35 USC 102(b) as being anticipated by Collins et al. has been withdrawn in view of amendments.

4.   The rejection of claims 1-7 and 28-30 under 35 USC 103(a) as being unpatentable over Simon et al. in view of Collins et al. has been withdrawn in view of amendments.

5.   The rejection of claims 10-12, 14, 19, and 24 under 35 USC 103(a) as being unpatentable Collins et al. over in view of Simon et al. has been withdrawn in view of amendments.

Double Patenting

6.   The rejection under Double Patenting has been withdrawn in view of the cancellation of claim 21.

Claim Rejections - 35 USC § 112

7.   The rejection of claim 11 under 35 USC 112 as being indefinite has been withdrawn in view of the amendment of the claim.

Claim Rejections - 35 USC § 103

8.   The text of those sections of Title 35, U.S. Code not included in this action can
be found in a prior Office action.

Claims 15-18, 20, 22-23, and 25-27 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Collins et al. (US Patent Number 5,781,714, issued on July 14,

1998) in view of Lipton (US Patent Number 5,940,581, issued on August 17, 1999).

9.   **Regarding independent claim 15,** Collins et al. discloses a method in which a

server receives requests for portable fonts (subsets) that are needed to display the web

page (electronic content) (column 40, lines 15-29 of Collins et al.). Collins et al.

discloses a method in which the requests are generated by a client computer based

upon HTML tags inserted into a web page that point to a file containing the font

descriptions and a look-up table for matching the portable font with the logical font

record (encoding scheme) (column 24, lines 1-28, column 29 lines 41-55, column 31,

lines 31-57, and column 40, lines 15-29 of Collins et al.). Collins et al. discloses a

method that once the portable fonts are obtained they are sent to the client computer

and used to display the current HTML file (column 40, lines 15-32 of Collins et al.).

Collins et al. does not disclose a method in which the directives are added to the

document in response to a request. However, Lipton discloses a method in which at the

time of request (for printing, imaging, etc.) a font subset is generated and processed for

the requested document (column 2, lines 25-61). It would have been obvious to one of

ordinary skill in the art at the time the invention was made to have combined the method

of using directives for font subsetting of Collins et al. with the method of dynamically

creating font subsets of Lipton because it would have always assured that the document

will be imaged in the most efficient manner that is consistent with the capabilities of the

device.

10.   **Regarding dependent claim 16,** Collins et al. discloses a method in which the

computers used have the ability to process the program instructions stored in memory

devices for this method (column 8, line 62-column 9, line 3 of Collins et al.).

11.   **Regarding dependent claim 17,** Collins et al. discloses a method in which the

computers used are personal computers and have the ability to process the program

instructions stored in memory devices for this method (column 8, line 62-column 9, line

3 of Collins et al.).

12.   **Regarding dependent claim 18,** Collins et al. discloses a method in which

portable fonts (subsets) are identified by HTML tags inserted into a web page that point

to a file containing the font descriptions and a look-up table for matching the portable

font with the logical font record (encoding scheme) (column 24, lines 1-28, column 29

lines 41-55, and column 31, lines 31-57 of Collins et al.). Collins et al. also discloses

that when a user requests a URL the modified version of the web page is the file that is

sent to them (column 38, line 53-column 39, line 4 of Collins et al.).

13.   **Regarding dependent claim 20,** Collins et al. discloses a method in which

portable font tags are identified in the modified HTML document (column 39, line 53-

column 40, line 5 of Collins et al.).

14.   **Regarding independent claim 22,** Collins et al. discloses a method in which a

HTML page can be loaded from local storage that contains HTML tags that point to files

containing font descriptions and a look-up table for matching the portable font with the

logical font record (encoding scheme) (column 24, lines 1-28, column 29 lines 41-55,

column 31, lines 31-57, and column 38, lines 36-42 of Collins et al.). Collins et al.

discloses a method in which portable font tags (directives) are identified in the modified

HTML document (column 39, line 53-column 40, line 5 of Collins et al.). Collins et al.

discloses a method in which the browser on the client computer determines whether or

not the portable font is in cache (local storage) on the client computer. If it is the HTML

document is displayed based on the portable font obtained from local cache otherwise a

request is made to the server to obtain that portable font (column 31, lines 3-20 of

Collins et al.). Collins et al. discloses a method that once the portable fonts are

obtained by the server device they are sent to the client computer and used to display

the current HTML file (column 40, lines 15-32 of Collins et al.). Collins et al. does not

disclose a method in which the directives are added to the document in response to a

request. However, Lipton discloses a method in which at the time of request (for

printing, imaging, etc.) a font subset is generated and processed for the requested

document (column 2, lines 25-61). It would have been obvious to one of ordinary skill in

the art at the time the invention was made to have combined the method of using

directives for font subsetting of Collins et al. with the method of dynamically creating

font subsets of Lipton because it would have always assured that the document will be

imaged in the most efficient manner that is consistent with the capabilities of the device.

15.

16.   **Regarding dependent claims 23 and 25-26,** the claims incorporate

substantially similar subject matter as claims 9, 14, and 17. Thus, the claims are

rejected along the same rationale as claims 9, 14, and 17.

17.   **Regarding dependent claim 27,** Collins et al. discloses a method in which the

browser on the client computer determines whether or not the portable font is in cache

(local storage) on the client computer. If it is the HTML document is displayed based on

the portable font obtained from local cache otherwise a request is made to the server to

obtain that portable font (column 31, lines 3-20 of Collins et al.).

Claims 1-14 and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Simon et al. (US Patent Number 6,065,008, filed on October 1, 1997) in view

of Collins et al. (US Patent Number 5,781,714, issued on July 14, 1998) further in

view of Lipton (US Patent Number 5,940,581, issued on August 17, 1999).

18.   **Regarding independent claim 1,** Simon et al. discloses a method in which a

web page (electronic content) is downloaded from the Internet (computer network),

which entails a request from a computer to a network device (column 1, lines 36-46 of

Simon et al.). Simon et al. discloses a method in which the web page is scanned by a

subsetting module to provide just enough of the rules and glyph information necessary

to view the web page which includes fonts (which may include different languages i.e.

Latin and Japenese) that are not local to the client device (column 1, lines 31-46 and

column 2, line 64-column 3, line 4 of Simon et al.). Simon et al. does not disclose that

only the glyphs identified in the requested document are used. However, Collins et al.

discloses a method in which only glyphs that are used in the document are contained

within the portable font (subset) (column 31, lines 31-44 of Collins et al.). It would have

been obvious to one of ordinary skill in the art at the time the invention was made to

have combined the methods of Simon et al. and Collins et al. because it would have

allowed for more efficient use of available space. Simon et al. does not disclose a

method in which directives are inserted into the electronic content to identify the glyph

subsets necessary or sending the modified file to the client. However, Collins et al.

discloses a method in which portable fonts (subsets) are identified by HTML tags

inserted into a web page that point to a file containing the font descriptions and a look-

up table for matching the portable font with the logical font record (encoding scheme)

(column 24, lines 1-28, column 29 lines 41-55, and column 31, lines 31-57 of Collins et

al.). Collins et al. also discloses that when a user requests a URL the modified version

of the web page is the file that is sent to them (column 38, line 53-column 39, line 4 of

Collins et al.). It would have been obvious to one of ordinary skill in the art at the time

the invention was made to have combined the method of Simon et al. and the method of

Collins et al. because it would have allowed for more efficient transmission of font

information. Neither Simon et al. nor Collins et al. disclose a method in which the

directives are added to the document in response to a request. However, Lipton

discloses a method in which at the time of request (for printing, imaging, etc.) a font

subset is generated and processed for the requested document (column 2, lines 25-61).

It would have been obvious to one of ordinary skill in the art at the time the invention

was made to have combined the method of using directives for font subsetting of Collins et al. and Simon et al. with the method of dynamically creating font subsets of Lipton because it would have always assured that the document will be imaged in the most efficient manner that is consistent with the capabilities of the device.

19.   **Regarding dependent claim 2,** Simon et al. discloses a method in which a font distributor server has non-volatile memory from which a subsetting module can be run on the processor (column 1, lines 34-51 of Simon et al.).

20.   **Regarding dependent claim 3,** Simon et al. discloses a method in which a web page is downloaded from the Internet, which entails a request from a computer to a network device (column 1, lines 36-46 of Simon et al.). It would have been obvious to one of ordinary skill in the art at the time the invention was made that web pages are written in Hyper Text Markup Language.

21.   **Regarding dependent claim 4,** Simon et al. discloses a method in which subsets can be generated for Japanese character sets (glyphs) (column 1, lines 31-36 of Simon et al.).

22.   **Regarding dependent claim 5,** Simon et al. discloses a method in which a web page is downloaded from the Internet, which entails a request from a computer to a network device (column 1, lines 36-46 of Simon et al.).

23.   **Regarding dependent claim 6,** Simon et al. discloses a method in which a personal computer is used by the user (column 5, lines 6-25 of Simon et al.).

24.   **Regarding dependent claim 7,** Simon et al. does not disclose a method in which directives are inserted into the electronic content as meta tags to identify the

glyph subsets necessary. However, Collins et al. discloses a method in which portable fonts (subsets) are identified by HTML style tags (header) inserted into a web page that point to a file containing the font descriptions and a look-up table for matching the portable font with the logical font record (encoding scheme) (column 24, lines 1-28, column 29 lines 41-55, and column 31, lines 31-57 of Collins et al.).

25.   **Regarding dependent claims 8 and 29,** Simon et al. discloses a method in which a web page (electronic content) is downloaded from the Internet (computer network), which entails a request from a computer to a network device (column 1, lines 36-46 of Simon et al.). Simon et al. discloses a method in which the web page is scanned by a subsetting module to provide just enough of the rules and glyph information necessary to view the web page which includes fonts (which may include different languages i.e. Latin and Japenese) that are not local to the client device (column 1, lines 31-46 and column 2, line 64-column 3, line 4 of Simon et al.). Simon et al. does not disclose a method in which directives are inserted into the electronic content to identify the glyph subsets necessary or sending the modified file to the client. However, Collins et al. discloses a method in which portable fonts (subsets) are identified by HTML tags inserted into a web page that point to a file containing the font descriptions and a look-up table for matching the portable font with the logical font record (encoding scheme) (column 24, lines 1-28, column 29 lines 41-55, and column 31, lines 31-57 of Collins et al.). Collins et al. also discloses that when a user requests a URL the modified version of the web page is the file that is sent to them (column 38, line 53-column 39, line 4 of Collins et al.). It would have been obvious to one of

ordinary skill in the art at the time the invention was made to have combined the method

of Simon et al. and the method of Collins et al. because it would have allowed for more

efficient transmission of font information. Neither Simon et al. nor Collins et al. disclose

a method in which the directives are added to the document in response to a request.

However, Lipton discloses a method in which at the time of request (for printing,

imaging, etc.) a font subset is generated and processed for the requested document

(column 2, lines 25-61). It would have been obvious to one of ordinary skill in the art at

the time the invention was made to have combined the method of using directives for

font subsetting of Collins et al. and Simon et al. with the method of dynamically creating

font subsets of Lipton because it would have always assured that the document will be

imaged in the most efficient manner that is consistent with the capabilities of the device.

26.   **Regarding dependent claim 9,** Simon et al. discloses a method in which the

computers used have the ability to process the program instructions stored in memory

devices for this method (column 5, lines 6-25 of Simon et al.).

27.   **Regarding dependent claim 10,** Collins et al. does not disclose the use of a

database from which the sets are retrieved. However, Simon et al. discloses a method

in which the font distributor has a font database from which the fonts are obtained

(column 4, lines 35-43 of Simon et al.). It would have been obvious to one of ordinary

skill in the art at the time the invention was made to have combined the methods of

Collins et al. and Simon et al. because a database would have allowed for organized

mass storage of large font sets.

28.   **Regarding dependent claim 11,** Simon et al. discloses a method in which the

font distributor has a font database from which the fonts are obtained and subsets of

fonts are stored, if a subset of a font exists it may be on the client computer if it does not

it will not be on the client computer (column 4, lines 35-43 of Simon et al.).

29.   **Regarding dependent claim 12,** Simon et al. discloses a method in which the

font distributor has a font database from which the fonts are obtained and subsets of

fonts are stored.

30.   **Regarding dependent claim 13,** Simon et al. does not disclose that requests

are received for documents including directives in HTML. However, Collins et al.

discloses a method in which portable fonts (subsets) are identified by HTML tags

inserted into a web page that point to a file containing the font descriptions and a look-

up table for matching the portable font with the logical font record (encoding scheme)

(column 24, lines 1-28, column 29 lines 41-55, and column 31, lines 31-57 of Collins et

al.). Collins et al. also discloses that when a user requests a URL the modified version

of the web page is the file that is sent to them (column 38, line 53-column 39, line 4 of

Collins et al.). It would have been obvious to one of ordinary skill in the art at the time

the invention was made to have combined the method of Simon et al. and the method of

Collins et al. because it would have allowed for more efficient transmission of font

information.

31.   **Regarding dependent claim 14,** Simon et al. discloses a method in which

subsets can be generated for Japanese character sets (glyphs) (column 1, lines 31-36

of Simon et al.).

32.   **Regarding independent claim 28,** Simon et al. discloses a method in which

subsets are developed to minimize the amount of space needed to identify glyphs that

are used to display electronic content in one or more desired languages (column 1, lines

31-46 and column 2, line 64-column 3, line 4 of Simon et al.). It would have been

obvious to one of ordinary skill in the art at the time the invention was made that by

minimizing the amount of space required to provide a font some devices that normally

wouldn't have had enough space to view a document would now be able to view it.

Simon et al. also discloses a method in which a personal computer is used to display

electronic content using characters from glyph subsets (column 5, lines 6-25 of Simon

et al.). Simon et al. does not disclose a method in which directives are used to identify

the glyph subsets. However, Collins et al. discloses a method in which portable fonts

(subsets) are identified by HTML tags (directives) inserted into an HTML page that point

to a file containing the font descriptions and a look-up table for matching the portable

font with the logical font record (encoding scheme) used to display an HTML

page(column 24, lines 1-28, column 29 lines 41-55, and column 31, lines 31-57 of

Collins et al.). It would have been obvious to one of ordinary skill in the art at the time

the invention was made to have combined the method of Simon et al. and the method of

Collins et al. because it would have allowed for more efficient transmission of font

information. Neither Simon et al. nor Collins et al. disclose a method in which the

directives are added to the document in response to a request. However, Lipton

discloses a method in which at the time of request (for printing, imaging, etc.) a font

subset is generated and processed for the requested document (column 2, lines 25-61).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of using directives for font subsetting of Collins et al. and Simon et al. with the method of dynamically creating font subsets of Lipton because it would have always assured that the document will be imaged in the most efficient manner that is consistent with the capabilities of the device.

33.   **Regarding dependent claim 30,** Collins does not disclose a method in which an entry is created to associate a client device with the subsets that were sent to it. However, Simon et al. discloses a method in which the font distributor has a font database from which the fonts are obtained and subsets of fonts are stored. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Collins et al. and Simon et al. with the use of a log, which by definition is a record of transactions that take place on a system (Microsoft Press Computer Dictionary, 1997), to determine what font subsets have already been transmitted to a client device because it would have allowed the use of locally stored font subsets more efficiently.

Claims 19 and 24 rejected under 35 U.S.C. 103(a) as being unpatentable over Collins et al. (US Patent Number 5,781,714, issued on July 14, 1998) in view of Lipton (US Patent Number 5,940,581, issued on August 17, 1999) as applied to claims 8, 15, and 22 above, and further in view of Simon et al. (US Patent Number 6,065,008, filed on October 1, 1997).

34.   **Regarding dependent claim 19,** Collins et al. does not disclose a method in

which the glyph subsets are Chinese, Japanese, Korean, Vietnamese, Hebrew or

Arabic glyphs. However, Simon et al. discloses a method in which subsets can be

generated for Japanese character sets (glyphs) (column 1, lines 31-36 of Simon et al.).

It would have been obvious to one of ordinary skill in the art at the time the invention

was made to have combined the method of Collins et al. and Simon et al. because it

would have allowed the user to view a wider range of unknown fonts.

35.   **Regarding dependent claim 24,** the claim contains substantially similar subject

matter as claim 14. Thus, the claim is rejected along the same rationale as claim 14.

Response to Arguments

36.   Applicant's arguments with respect to claims 1-20 and 22-30 regarding the

limitation "...inserting one or more directives into the requested content in response to a

request for the electronic content..." have been considered but are moot in view of the

new ground(s) of rejection.

37.   Applicant's arguments filed 5/4/2004 have been fully considered but they are not

persuasive.

Regarding the applicant's arguments about the rejection of claims under 35 USC

103(a), most specifically the limitation "... receiving a request for a document", it is

shown in the original rejection that it is inherent in the disclosure of Simon et al., in

addition to this the examiner shows that the teachings of Collins et al. further clarify that

a document is requested, and based on the obviousness set forth in the rejection it

would have not only been inherently shown by Simon et al. but shown to be obvious by

Collins et al.

Conclusion

38.   Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Joshua D Campbell whose telephone number is

(703)305-5764. The examiner can normally be reached on M-F (8:00 AM - 4:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Heather Herndon can be reached on (703)308-5186. The fax phone

number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JDC
July 13, 2004
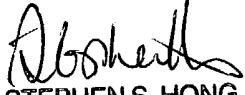
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